Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS NOWECK, KLAUS DIBLITZ,
and JAN SOHIEFLER

Appeal No. 2000-1420
Application No. 08/875,528

HEARD: April 16, 2002

Before, KIMLIN, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 13-17, 19-22 and 24-32, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method for making hydrotalcites of a specified formula from divalent and trivalent metal alcoholates. An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below.

13. A process for producing high purity hydrotalcites which are stratiform, anionic mixed metal hydroxides of the general formula

$$M_{2x}^{2+}M_2^{3+}(OH)_{4x+4} \cdot A_{2/n}^{n-} \cdot zH_2O$$

wherein M_{2x}^{2+}, M_2^{3+} are divalent and trivalent metal(s) respectively, x ranges from 0.5 to 10 in intervals of 0.5, A is an interstitial anion selected from the group consisting of a hydroxide anion and an organic anion, n is the charge of said interstitial anion, and z is an integer of 1 to 6, comprising

(A) mixing at least one divalent metal alcoholate with at least one trivalent metal alcoholate, both metal alcoholates being metal alcoholates of mono-, di-, or trihydric C1 to C40 alcoholates, where said mono-, di-, and trihydric metal alcoholates being mixed in a molar ratio corresponding to the stoichiometry of the formula referred to hereinabove, and

(B) hydrolyzing the resultant alcoholate mixture with water, the water for hydrolysis being used in stoichiometric excess, referring to the reactive valences of the metals used and where the source of the interstitial anions for A is from the water-soluble anions contained in the water for hydrolysis.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Miyata et al. (Miyata '523)	3,879,523	Apr. 22, 1975
Miyata et al. (Miyata '525)	3,879,525	Apr. 22, 1975
Miyata et al. (Miyata '814)	4,351,814	Sep. 28, 1982
Miyata et al. (Miyata '626)	4,629,626	Dec. 16, 1986
Wautier et al. (Wautier)	4,968,498	Nov. 06, 1990

Claims 13-17, 19-22 and 24-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Miyata '523 or Miyata '525 in view of Miyata '814 or Miyata '626. Claims 13-17, 19-22 and 24-32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wautier in view of Miyata '814 or Miyata '626.

OPINION

We refer to the briefs and to the answer for a complete exposition of the respective positions advocated by appellants and the examiner concerning the above noted rejections. Upon careful consideration of the opposing arguments presented on appeal, we concur with appellants that the examiner fails to establish how the applied prior art establishes a prima facie case of obviousness of the claimed subject matter. Accordingly, we will not sustain the examiner's rejections.

When an examiner is determining whether a claim should be rejected under 35 U.S.C. § 103, the claimed subject matter as a whole must be considered. See Ex parte Ochiai, 71 F.3d 1565, 1569, 37 USPQ2d 1127, 1131 (Fed. Cir. 1995). The subject matter as a whole of process claims includes the starting materials and product made. When the starting and/or product materials of the prior art differ from those of the claimed invention, the examiner has the burden of explaining why the prior art would

have motivated one of ordinary skill in the art to modify or select from the materials of the prior art processes so as to arrive at the claimed invention. See Ochiai, 71 F.3d at 1570, 37 USPQ2d at 1131. In the present case, the examiner has not carried this burden.

The examiner (answer, pages 3 and 4) takes the position that none of Miyata '523, Miyata '525 or Wautier (the primary references) disclose a method that results in the appellants' product hydrotalcite. The examiner further asserts that Miyata '814 or Miyata '626 teach the claimed hydrotalcite. The examiner does not offer a specific analysis of the methods of formation of the hydrotalcite products presented in Miyata '814 or Miyata '626 and how they may or may not be similar or different the methods of the relied upon primary references in the statement of the rejections. Nor does the examiner offer a convincing response to appellants' contentions that the methods of making the hydrotalcites taught by Miyata '814 or Miyata '626 are different from the process claimed herein. See pages 7-13 of the brief and the answer. Rather, the examiner (answer, page 5) reasons that:

> since the primary references teach a general procedure for making hydrotalcites it would have been obvious to one skilled in the art to make the instantly claimed known hydrotalcite by the taught processes of

> the primary references because they too are drawn to processes for making hydrotalcites.

The examiner simply has not adequately explained how and why one of ordinary skill in the art would have been led to modify any of the processes of Miyata '523, Miyata '525 or Wautier so as to form appellants' claimed hydrotalcite of the formula specified in the appealed claims, which includes an hydroxide or organic ion A, while using a reactant mixture of divalent and trivalent metal alcoholates. Thus, the examiner has not reasonably established how the combined references would have led one of ordinary skill in the art to a modify the process of any of the primary references so as to arrive at appellants' process as called for in any of the claims on appeal. In this context, the examiner's rejections fall short in not identifying a convincing and particularized suggestion, reason or motivation to combine the references or make the proposed modification in a manner so as to arrive at the claimed invention. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

CONCLUSION

The decision of the examiner to reject the appealed claims under 35 U.S.C. § 103 as being unpatentable over Miyata '523 or Miyata '525 in view of Miyata '814 or Miyata '626, and to reject

the appealed claims under 35 U.S.C. § 103 as being unpatentable over Wautier in view of Miyata '814 or Miyata '626 is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)	
PETER F. KRATZ Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

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APPEAL NO. - JUDGE KRATZ
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DECISION: **ED**

Prepared By:

DRAFT TYPED: 04 Jun 03

FINAL TYPED: